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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR       | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
|---|-------------|----------------------------|---------------------------------|------------------|
| 10/003,900  | 10/25/2001  | Peter Worthington Hamilton | 8762                            | 7654             |
| 27752   | 7590        | 04/13/2004                 |                                 |                  |
| THE PROCTER & GAMBLE COMPANY<br>INTELLECTUAL PROPERTY DIVISION<br>WINTON HILL TECHNICAL CENTER - BOX 161<br>6110 CENTER HILL AVENUE<br>CINCINNATI, OH 45224 |             |                            | EXAMINER<br>SIMONE, CATHERINE A |                  |
|   |             |                            | ART UNIT<br>1772                | PAPER NUMBER     |

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------|--------------------------------------|--|--|
| <b>Advisory Action</b> | <b>Application No.</b><br>10/003,900 | <b>Applicant(s)</b><br>HAMILTON ET AL. |  |
|                        | <b>Examiner</b><br>Catherine Simone  | <b>Art Unit</b><br>1772                |  |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7/21/03 and 8/08/03.
10. ☐ Other: \_\_\_\_\_

*Advisory Action*

*Response to Arguments*

Applicant's arguments filed 3/17/04 have been fully considered but they are not persuasive.

Applicant's argue that "Applicants are at a loss to understand how an adhesive coating having a thickness ranging from about 0.00001 inch to about 0.0002 inch is suggested by the McGuire reference. Applicants' claimed adhesive thickness is at least one order of magnitude less than the thickness disclosed in the McGuire reference. The claimed adhesive, applied to a substrate at a thickness that is at least one order of magnitude less than that of the cited prior art and provides sufficient adhesive properties to form a bond to most common materials that is sufficiently strong so as to survive handling without failure (p. 8,11. 21-24), is significant difference over the cited prior art. Applicants respectfully submit that the prior art is so deficient that there is no motivation to make what might otherwise appear to be obvious changes.... It is hard to fathom how an adhesive applied to a substrate of a thickness that is at least one order of magnitude less than the range cited in the prior art can be a "discovery of an optimum or workable range," as the Examiner suggests."

However, it is to be pointed out that in the absence of showing unexpected results, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the adhesive coating composition in McGuire to have a thickness from about 0.00001 inches (0.00025 mm) to about 0.0002 inches (0.0051 mm), since it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. MPEP 2144.05 II (A).

Furthermore, Applicant's argue that "the examples provided in the submitted Declaration are of probative value because they do involve a comparison of Applicant's invention with the closest


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applied prior art." However, the declaration is merely drawn to Applicant's opinion of the prior art cited by the Examiner. There is no showing of unexpected results. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). Furthermore, the examples in the Declaration are of no probative value in determining patentability of claims since they do not involve a comparison of Applicant's invention with the closest applied prior art. See *In re De Blawe*, 222 USPQ 191 (Fed. Cir. 1984), and *In re Fenn*, 208 USPQ 470 (CCPA 1981).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Catherine Simone  
Examiner  
Art Unit 1772  
April 5, 2004

  
**SANDRA M. NOLAN**  
PRIMARY EXAMINER